

**REMARKS**

By this amendment, claims 1, 3-5, 7, 8, 10-12, 14, 15, 17-19, 21, 22, 24-26, and 28-38 are pending, in which claims 2, 9, 16, 23 and 39 are canceled without prejudice or disclaimer, and claims 1, 8, 15, and 22 are amended. Claims 6, 13, 20, and 27 were previously canceled. Care was exercised to avoid the introduction of new matter.

The final Office Action mailed June 30, 2005 rejected claims 1, 7, 8, 14, 15, 21, 22, 28, 29, 31, and 34-36 under 35 U.S.C. § 103(a) as obvious based on *Carneal et al.* (US 6,282,542 B1) in view of *Persistent Client State HTTP Cookies* ([http://wp.netscape.com/newsref/std/cookie\\_spec.html](http://wp.netscape.com/newsref/std/cookie_spec.html)) [hereinafter *Netscape*], and claims 2, 9, 16, and 23 as obvious under § 103(a) based on *Carneal et al.* and *Netscape* in further view of *Eilbott et al.* (US 6,553,393 B1). Claim 3 was rejected under § 103(a) as obvious based on *Carneal et al.* and *Netscape* in further view of *Sridhar et al.* (US 6,226,701 B1), and claim 4 was rejected under § 103(a) as obvious based on *Carneal et al.* and *Netscape* in further view of *Quantum Prime Communications* ([www.qpcomm.com/vsat\\_info.html](http://www.qpcomm.com/vsat_info.html)) [hereinafter *Quantum*]. Furthermore, claims 10, 17, and 24 were rejected under § 103(a) as obvious based on *Carneal et al.*, *Netscape*, and *Eilbott et al.* in further view of *Sridhar et al.*, and claims 11, 18, and 25 were rejected under § 103(a) as obvious based on *Carneal et al.*, *Netscape*, and *Eilbott et al.* in further view of *Quantum*. Claims 5, 12, 19, and 26 were rejected under § 103(a) as obvious based on *Carneal et al.* and *Netscape* in further view of *Marks et al.* (US 6,463,447 B1), and claims 30, 33, 37, and 39 were rejected under § 103(a) as obvious base on *Carneal et al.* and *Netscape* in further view of *Harrison et al.* (US 6,249,914 B1). Additionally, claims 22-28 were rejected under § 101 as directed to non-statutory subject matter, and claims 1-39 were rejected under § 112, first paragraph, as failing to comply with the written description requirement. Finally, claims 37 and 38 were rejected under § 112, second paragraph, as indefinite.

The Specification is amended to correct discovered informalities.

Regarding the § 101 rejection, Applicants respectfully traverse the rejection. The Office Action, on page 2, misconstrues *O'Reilly v. Morse*, 56 U.S. (15 How.) 62 (1853) and *In re Breslow*, 616 F.2d 516 (C.C.P.A. 1980) as "merely stat[ing] that a signal claim cannot be held to be non-statutory merely because of its transitory nature." Further, the Office Action reconfirms its rejection stating, "[a] claim to a computer program requires that the program necessarily be tangibly embodied on a computer readable medium . . .

claims 22-28 include multiple intangible embodiments, and are therefore non-statutory.” However, the MPEP § 2106(IV)(B)(2)(b), in pertinent part, clearly conditions, “[t]o be statutory, a claimed computer-related process must . . . **be limited to a practical application** within the technological arts.” See also *O’Reilly*, 56 U.S. at 114-19 (holding that the “unpatentability of the principle does not defeat patentability of its practical applications”). Furthermore, MPEP § 2106(IV)(B)(2)(b)(ii) conditions that, “[a] claim is limited to a practical application when the method, as claimed, **produces a concrete, tangible and useful result.**” As claimed, claim 22 produces the concrete, tangible and useful result of “providing content to a client,” as positively recited in the preamble. Moreover, the method carried out by the computer-readable medium contributes to the advantageous, overall reduction in user response time associated with web browsing as stated within the Specification on page 3, paragraph [12]. Therefore, claim 22 and those claims dependent therefrom (i.e., 23-28) are statutory under § 101 as they embody a practical application producing a concrete, tangible, and useful result.

Regarding the rejection under § 112, first paragraph, the amendment changes the language of claims 1 and 35 as follows: “include the cookie in a read-ahead request to retrieve the ~~content~~ object.” Also, the amendment removes the claim language “in accordance with the cookie.” Hence, the amendment renders the rejection moot.

Regarding the § 112, second paragraph rejection, Applicants have amended dependent claims 37 and 38 to particularly point out and distinctly claim the subject matter of the invention. Thus, the rejection under 35 U.S.C. § 112, second paragraph, is believed to have been overcome, and no further rejection on that basis is anticipated. If, however, the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually satisfactory claim language.

To advance prosecution, independent claims 1, 8, 15, and 22 have been amended to incorporate features of dependent claims 2, 9, 16 and 23, respectively. Independent claim 35 is also amended to include features of dependent claim 39 (now canceled). Amended independent claim 1 recites “an upstream proxy server configured to . . . **forward the object based on a predetermined criteria relating to the object, including life of the object**, over a data network to the downstream proxy server prior to the client transmitting another message requesting the object.” Independent claims 8 and 22 are amended to recite “**forwarding the object** over a communications link to the downstream server **based**

on a predetermined criteria relating to the object, wherein the predetermined criteria includes life of the object, prior to the client transmitting a message requesting the object.” Claim 15 now includes the features of “means for forwarding the object over a communications link to the downstream server based on a predetermined criteria relating to the object, including life of the object, prior to the client transmitting a message requesting the object.” Amended claim 35 now recites “receiving a message from a client requesting content specifying an object from a content server, wherein the message includes a cookie specifying a forwarding criterion” and “receiving, from the upstream server, the object based on the forwarding criterion over a data network prior to the client transmitting another message requesting the object.”

In rejecting claims 2, 9, 16 and 23, the Office Action applies *Eilbott et al.* However, *Eilbott et al.* makes no mention of “life of the object,” as positively recited. *Eilbott et al.* merely discloses, “[u]sing the size information, the proxy server may selectively determine which images should be prefetched. Of course, attributes other than size (e.g., reference type, characteristics, etc.) may be used by the proxy server to generate the list.” (Col. 7, lines 51-55). At best, *Eilbott et al.* discusses, in generalities, about the possibility of other “attributes.” MPEP § 2143.03 specifically states, in order “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” See also *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). Furthermore, in *Ex parte Obukowicz*, the court held general guidance suggestions that make an approach “obvious to try” do not make the invention obvious. 27 USPQ2d 1063, 1065 (B.P.A.I. 1992).

Even assuming the references of *Carneal et al.* and *Netscape* were properly combined based on some teaching or suggestion in the references, and assuming the modifications proposed in the Office Action were justified by additional teachings or suggestions found in the references, even the combination does not render the claimed invention obvious. Specifically, none the references taken alone, or in combination, teaches or suggests “forward the object based on a predetermined criteria relating to the object, including life of the object.”

Further, it is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicants’ structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion

thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967). In this instance, no suggestion exists within *Carneal et al.* for the use of cookies in the manner claimed, as properly acknowledged by the Office Action (page 6). The *Netscape* reference does not provide any suggestion for the proposed modification to the *Carneal et al.* system, disclosing only the general functions associated with HTTP cookies.

Regarding amended independent claim 35 (which incorporates the features of dependent claim 39), the Office Action again engages in hindsight reconstruction; this time further conglomerating *Harrison et al.* to the suspect combination of *Carneal et al.* and *Netscape*. Pursuant to MPEP §2141.01(a), the examiner must determine what is “analogous prior art” for the purpose of analyzing obviousness. In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992); and *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). In the case at hand, the *Harrison et al.* system addresses the problem encountered by mass market broadcast programming to deliver data associated by its relevancy to its subject matter that could be interactively displayed and manipulated by consumers on a real time basis (col. 2: 5-13). Applicants submit that one of ordinary skill when faced with the problem of mitigating delay in a high latency network would not consult *Harrison et al.*

Furthermore, the *Harrison et al.* system’s notion of determining cacheability is very different from the claimed invention, and in fact, teaches away the claimed invention. *Harrison et al.* (col. 13: 22) discloses the following (*Emphasis added*):

... parser 408 is responsible for parsing the separated associated data to determine whether the associated data objects are of a cacheable type or a non-cacheable type, and identified them for local data manager 38 accordingly. The classification of cacheable and non-cacheable associated data objects are application dependent. **Any number of associated data object types, like text etc., may be classified as non-cacheable, whereas any number of other associated data object types, like HTML pages, may be classified as cacheable.** Furthermore, any one of a number of known techniques may be employed to determine and identify whether an associated data object is a cacheable or a non-cacheable type. In other embodiments, parser 408 also extracts

property information describing the associated data objects from the associated data objects. Examples of property information include whether an associated data object contains adult content, inappropriate subject matter, or content unsuitable to the viewer age group and so forth.

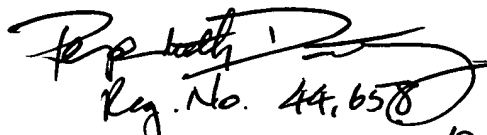
The above passage suggests that all HTML pages are cacheable, thereby undercutting the objective of avoiding transmissions over the high latency communication link. As a further teaching away, the *Harrison et al.* discloses that the announcement messages associated with non-cacheable data objects are provided to the attached clients (col. 14: 1-12); this makes the caching process not transparent to the clients. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Therefore, the obviousness rejection over the combination of *Carneal et al.*, *Netscape*, and *Harrison et al.* is unsustainable.

Accordingly, Applicants respectfully request the indication that amended independent claims 1, 8, 15, 22, and 35 be allowable, along with the corresponding dependent claims 2-5, 7, 9-12, 14, 16-19, 21, 23-26, 28-34, 36-38.

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration of this application is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (301) 601-7252 so that such issues may be resolved as expeditiously as possible. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

  
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